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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/717,460  | 11/21/2003  | David F. Skoll       | 9-14774-1US-1-1     | 8046             |
| 20988   | 7590        | 05/09/2005           | EXAMINER            |                  |
| OGILVY RENAULT LLP<br>1981 MCGILL COLLEGE AVENUE<br>SUITE 1600<br>MONTREAL, QC H3A2Y3<br>CANADA |             |                      | DINH, PAUL          |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2825                |                  |

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/717,460             | SKOLL ET AL.        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Paul Dinh              | 2825                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 36-40 and 78-87 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-40 and 78-87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/21/03</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This is a response to the election without traverse filed on 4/14/05.

### Claims Status

Claims 72-77 cancelled.

Pending claims = claims 36-40 (amended) and claims 78-87 (newly added).

### Claim Objections

The following claims are objected to because:

(Claim 40) “*can be*” is not a positive recitation of the invention and should not be used in the claim language.

(Claim 80) “a different engineer analysts” should be changed to “a different engineer analyst”

### Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 36 is rejected under 35 U.S.C. 112, first paragraph as being a “single means” claim (“*comprising means for enabling parallel design analysis of the image-mosaics by a plurality of engineer analysts concurrently reverse engineering an IC*”), note MPEP 2164.08 (a).

Claims 37-40 and 78-80 are rejected because they depend on claim 36.

*The following is a quotation of the second paragraph of 35 U.S.C. 112:*

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.*

Claims 78, 81 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 78, 81 are rejected because “multi-user extensions” is not clearly described in claim 81 and in specification. Claims 82-87 are rejected because they depend from claim 81.

**Claim Rejections - 35 USC § 102**

*The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:*

*A person shall be entitled to a patent unless –*

*(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

*(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

1. Claims 36-37, 78, 81-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Skoll et al (USP 6671424)

*The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.*

(Claims 36, 78, 81) means for enabling parallel design analysis of the image-mosaics (fig 1-6, 10-20) by a plurality of engineer analysts concurrently reverse engineering an IC (background, fig 1, col 11-12) by providing multi-user extensions to synchronize work of multiple engineer analysts working on an IC reverse engineering project (background, fig 1, col 11-12).

*(For the means and/or multi-user extension, see one or more of: (multiple) computer(s)/workstations, workstation(s) being programmed to respond in real time, algorithm, program, remote access/services, server, Network, LAN, WAN, server, system, browser, network, internet, on-line multiple media system, distribute window environment, and interface in this prior art)*

(Claims 37, 82) wherein the plurality of image-mosaics are annotated concurrently using a plurality of design analyst workstations (col 3 line 23).

2. Claims 36-37, 78, 81-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Lam et al (USP 5694481).

(Claims 36, 78, 81) means for enabling parallel design analysis of the image-mosaics (abstract, background, summary, fig 1-3) by a plurality of engineer analysts (col 1 lines 29-33) concurrently reverse engineering an IC (col 1 line 20) by providing multi-user extensions to synchronize work of multiple engineer analysts working on an IC reverse engineering project (col 1 line 20).

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*(For the means and/or multi-user extension, see one or more of: (multiple) computer(s) system, workstations, workstation being programmed to respond in real time, algorithm, program, remote access/services, server, Network, LAN, WAN, server, system, browser, network, internet, on-line multiple media system, distribute window environment, and interface in this prior art)*

(Claims 37, 82) wherein the plurality of image-mosaics is annotated concurrently using a plurality of design analyst workstations (fig 1-3).

### ***Claim Rejections - 35 USC § 103***

*The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections, set forth in this Office action:*

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

3. Claims 38-40, 80, 83-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lam et al (USP 5694481) in view Trinchieri (USP 4224664)

(Claims 38, 80) Lam discloses substantially all the elements in claims 38, 80 except one user/designer/engineer/analyst at a time (in claim 38) and lock feature (in claim 80)

Trinchieri discloses one user/designer/engineer/analyst at a time and lock feature in col 3 lines 20-22, col 6 line 26+).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use features one user/designer/engineer/analyst at a time and lock feature to achieve one or more of the followings: avoid the contradiction, control the read/write, and maintain data/information integrity, avoiding/eliminating interferences/inconsistencies, providing protection for multiprocessing environment among the accesses from a plurality of users

(Claims 39, 84) unique identification strings (abstract, col 14 lines 11-60, fig 8, 14-16).

(Claims 40, 83, 85) different ownership attribute can be merged for display on one design analysis workstation (col 6 line 33+, col 13, line 11+, workstation = computer system).

(Claims 79, 86-87) lock feature to prevent accidental modification, interference editing, signal conflicts (col 3 lines 20-22, col 6 line 26+).

4. Claims 36-40, 78-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phaneuf et al (USP 6288393) in view Ernst (USP 6591278)

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(Claims 36, 78, 81) means for enabling parallel design analysis of the image-mosaics by reverse engineering an IC (abstract, col 1-2, 5, 7, 9, fig 1)

Thus, Phaneuf discloses all the elements in claims 36, 81 (image-mosaics + reverse engineering an IC) except providing multi-user extensions to synchronize (concurrent) work of multiple engineer analysts.

Ernst discloses multi-user extensions to synchronize (concurrent) work of multiple engineer analysts (fig 1-2, 4-7, 13-14)

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide multi-user extensions to synchronize (concurrent) work of multiple engineer analysts in order to **(one or more of the following reasons):**

- a. permit users to interrelate information from different locations or different tools (abstract)
- b. Permit engineering teams working concurrently between different locations and organizations (col 1).
- c. Permit engineering teams of different disciplines/locations concurrently working on a product/design, working together (col 1).
- d. Share information and coordination/cooperation of the flow of work/information between all of the project participants (col 1)
- e. Share information between the engineers to facilitate the concurrent of a product (col 3)
- f. Permit any engineer to access the project regardless what tools being used by the engineer (col 3)
- h. Update real-time information among engineers (col 3)
- i. Distribute and/or manage project/design (col 1, 3).

See Ernst for the following rejections:

(Claims 37, 82) plurality of design analyst workstations (fig 1-2, 4-7, 13-14)

(Claims 38) one user/designer/engineer/analyst at a time (fig 1-2, 4-7, 13-19)

(Claims 39, 84) unique identification strings (fig 1-2, 4-7, 13-19)

(Claims 40, 83, 85) different ownership attribute can be merged for display on one design analysis workstation (fig 1-2, 4-7, 10-19)

(Claims 79-80, 86-87) lock feature to prevent accidental modification, interference editing, signal conflicts (col 3 line 34+, col 13 line 58+, col 14 line 54+, claims 8-9).

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Dinh whose telephone number is 571-272-1890. The examiner can normally be reached on Monday to Friday from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Smith can be reached on 571-272-1907. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Dinh

Patent Examiner

A handwritten signature in black ink that reads "Paul Dinh". The signature is written in a cursive style with a long, sweeping underline that extends to the right.